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Commissioner for Patents
United States Patent and Trademark Office
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06 DEC 2006

Smith Gambrell & Russell
1850 M Street, N. W., Suite 800
Washington DC 20036

In re Application of	:	
RUSSELL et al.	:	
Application No.: 10/522,809	:	DECISION
PCT No.: PCT/AU03/00393	:	
Int. Filing Date: 31 March 2003	:	
Priority Date: 31 July 2002	:	
Attorney Docket No.: 034164.002	:	
For: ANIMATED MESSAGING	:	

This is a decision on applicants' renewed petition under 37 CFR 1.47(a) filed 17 November 2006 in the United States Patent and Trademark Office (USPTO).

BACKGROUND

On 31 March 2003, applicants filed international application PCT/AU03/00393, which designated the United States and claimed a priority date of 31 July 2002. A copy of the international application was communicated from the International Bureau to the USPTO on 05 February 2004. The thirty-month period for paying the basic national fee in the United States expired at midnight on 31 January 2005.

On 31 January 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee and an assertion of small entity status.

On 09 June 2005, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) and the surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty months from the priority date were required.

On 10 November 2005, applicants filed a submission which included, *inter alia*, a petition/fee for a four month extension of time, a declaration of inventors, and the surcharge under 37 CFR 1.492(e) for providing the declaration of inventors later than thirty months from the priority date.

On 23 November 2005, applicants filed a "DECLARATION OF NICHOLAS RUSSELL IN SUPPORT OF ONE CO-INVENTOR SIGNING ON BEHALF OF ANOTHER".

On 30 January 2006, a decision treating the submissions filed 10 November 2005 and 23 November 2005 together as a petition under 37 CFR 1.47(a) was mailed dismissing the petition without prejudice. Specifically, it was noted that factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort had not been provided and that a clear statement of the last known address of the missing inventor had not been provided.

On 28 March 2006, applicants submitted a renewed petition under 37 CFR 1.47(a) which was accompanied by an appendix which contains various purported e-mails between Nick Russell and Anton Felich.

On 05 May 2006, a decision was mailed dismissing applicants' renewed petition under 37 CFR 1.47(a) without prejudice. Specifically, it was noted that factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort had not been provided.

On 05 July 2006, applicants filed a renewed petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, a declaration of facts by Nicholas Russell.

On 27 September 2006, a decision was mailed dismissing applicants' petition under 37 CFR 1.47(a). Specifically, it was noted that had been provided but that, upon further review, the declaration of inventors filed 10 November 2005 was not in compliance with 37 CFR 1.497(a)-(b) because the international application indicates the inventor as *Andrew* Felich while the declaration of inventors filed 10 November 2005 identifies the inventor as Anton Felich. The decision noted that if applicant's correct name is Anton Felich, as would appear to be the case, an acceptable explanation of how applicant was named as Andrew Felich rather than Anton Felich in the international publication is required.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17(h); (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort; (3) a statement of the last known address of the missing inventor; and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

As noted in the decision mailed 05 May 2006, items (1) and (3) have been met.

As noted in the decision mailed 27 September 2006, item (2) has been met.

Item (4) has now been met as well. The renewed petition states that the international application indicated the inventor's first name as Andrew rather than Anton because of a clerical

error. The renewed petition further states that the error was discussed with applicants' representatives who indicated that the error could be corrected at a future stage in the application process. However, it does not appear that applicants' representatives corrected this problem during the international phase under PCT Rule 92bis. Applicants' explanation of the difference in the translation of Anton Felich's name is accepted and noted for the record.

CONCLUSION

For the above reasons, applicants' renewed petition under 37 CFR 1.47(a) is **GRANTED**.

As provided in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to non-signing inventor at his last known address of record.

A notice of the filing of the application under 37 CFR 1.47(a) will be published in the Official Gazette.

This application is being forwarded to the National Stage Processing Branch of the Office of PCT Operations to continue national stage processing of the application, including the accordation of a 35 U.S.C. §§371(c)(1), (c)(2), and (c)(4) date of **10 November 2005**.



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ANTON FELICH
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In re Application of
RUSSELL et al.
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For: ANIMATED MESSAGING

Dear Mr. Felich:

You are named as an inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost per 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

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